

REMARKS

The Office Action mailed February 8, 2005, has been received and reviewed. Claims 1 through 27 are currently pending in the application, of which claims 1 through 13 and 18 through 22 are currently under examination. Claims 14 through 17 and 23 through 27 are withdrawn from consideration as being drawn to a non-elected invention, and have been canceled. Applicants herein acknowledge the restriction requirement in the above-referenced application, and affirm the election to prosecute the claims of Group I, claims 1 through 13 and 18 through 22, without further traverse. Claims 1 through 13 and 18 through 22 stand rejected. Applicants have canceled claims 8, 14 through 17 and 23 through 27, amended claims 1 and 13, and respectfully request reconsideration of the application as amended herein.

Applicants have amended claim 1 to enhance clarity of the recited method by specifying characteristics of the resilient material to be permanently enhanced by treating and to recite deforming at least a portion of the at least one electrically isolated spring-biased electrical contact to extend away from the at least one of the first and second surfaces of the substrate.

Applicants have amended claim 13 to conform to the amendments to claim 1.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 5,802,699 to Fjelstad et al.

Claims 1 through 3, 6 through 13, and 18 through 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fjelstad et al. (U.S. Patent No. 5,802,699). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1, as amended, is respectfully asserted to patentably define over the reference. Applicants submit that the reference fails to describe at least deforming at least a portion of an electrical contact to extend away from a surface of a substrate on which the contact is disposed.

Amendments to the Drawings:

The attached replacement sheet of drawings includes changes to FIGS 1 and 2, specifically the legend "PRIOR ART" has been added to both drawing figures as suggested by the Examiner. This sheet, which includes only FIGS. 1 and 2, replaces the original sheet including FIGS. 1 and 2.

Further, Applicants respectfully assert that the “treating” asserted by the Office as being effected to the electrical contacts of the reference does not permanently enhance strength and elasticity of at least a portion of the contacts, as is now claimed. Moreover, Applicants respectfully note that the etching relied upon by the Office as a “treating” act is, in fact, used to form the contacts, or complete the formation thereof, and not to perform any operation on a contact as formed.

Accordingly, the reference fails to anticipate the claim.

Claims 2, 3, 6, 7, 9 through 13 and 18 through 22 are allowable as depending from claim 1 as amended herein.

Anticipation Rejection Based on U.S. Patent No. 4,950,173 to Minemura et al.

Claims 1 through 8, 12, 13, 18, 19, 21 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Minemura et al. (U.S. Patent No. 4,950,173). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants respectfully assert that claim 1, as amended, patentably defines over the reference. More specifically, Applicants note that the electrical contacts of the reference have no portion deformed to extend away from a surface of a substrate on which they are disposed. The contacts of the reference are formed of a shape memory alloy and include protrusions which extend over an aperture in the substrate, and are deformed thereinto. The protrusions are “trained” to deflect into the aperture under extremely low (liquid nitrogen) temperatures, and to return to an undeflected position and grip a lead or pin inserted in the aperture while the protrusions are in a deflected state when the substrate is returned to a higher, room temperature. Further, the “treatment” used on the electrical contacts does not permanently enhance strength or elasticity of the protrusions, but merely fixes their memory. Accordingly, the reference fails to anticipate the claim.

Claims 2 through 7, 12, 13, 18, 19, 21 and 22 are allowable as depending from claim 1.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,802,699 to Fjelstad et al. in view of U.S. Patent No. 4,950,173 to Minemura et al.

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fjelstad et al. (U.S. Patent No. 5,802,699) in view of Minemura et al. (U.S. Patent No. 4,950,173). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The nonobviousness of independent claim 1 precludes a rejection of claims 4 and 5 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Claims 4 and 5 are, therefore, allowable as depending from claim 1.

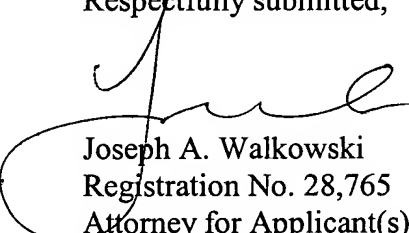
ENTRY OF AMENDMENTS

The amendments to claims 1 and 13 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search.

CONCLUSION

Claims 1 through 7, 9 through 13 and 18 through 22 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



Joseph A. Walkowski
Registration No. 28,765
Attorney for Applicant(s)
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: May 9, 2005

Attachment: Replacement Sheet of Formal Drawings

JAW/djp:slm
Document in ProLaw